

**UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK**

NEW YORK ROAD RUNNERS, INC., Plaintiff, v. NEW YORK CITY RUNS, INC., Defendant.	1:24-cv-01231-DG-JAM <u>ANSWER AND AFFIRMATIVE DEFENSES</u>
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Defendant New York City Runs, Inc. (“NYCRUNS”), by and through its attorneys, answer and state their affirmative defenses to Plaintiff New York Road Runners, Inc.’s (“NYRR”) Complaint dated February 16, 2024 (ECF No. 1). Any allegation not expressly addressed herein is hereby denied.

NATURE OF THE ACTION

1. NYCRUNS denies the allegations in Paragraph 1, except that it states that it lacks knowledge or information sufficient to form a belief as to the truth of the allegation concerning the length of time that NYRR has supposedly used BROOKLYN HALF and BROOKLYN HALF MARATHON as trademarks for NYRR’s half-marathon running event.

2. NYCRUNS denies the allegations in Paragraph 2, except that it admits it has offered its half-marathon running event under the NYCRUNS BROOKLYN HALF MARATHON mark.

3. NYCRUNS denies the allegations in Paragraph 3.

4. NYCRUNS denies the remaining allegations in Paragraph 4, except that it admits that it is offering a half-marathon running event in 2024 under the mark NYCRUNS BROOKLYN HALF MARATHON.

5. NYCRUNS denies the allegations in Paragraph 5, except that it admits only that this is an action for alleged trademark infringement and unfair competition.

THE PARTIES

6. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 6.

7. NYCRUNS denies the allegations in Paragraph 7, except that it admits that NYCRUNS is a New York corporation with its principal place of business in Brooklyn, New York.

JURISDICTION AND VENUE

8. NYCRUNS admits only that NYRR has brought this civil action pursuant to the Lanham Act, 15 U.S.C. § 1051, *et seq.*, the New York General Business Law, Sections 349 and 360-L, and the common law of the State of New York. NYCRUNS denies that NYRR has asserted viable claims and the remaining allegations of Paragraph 8.

9. NYCRUNS admits that this Court has subject matter jurisdiction.

10. NYCRUNS denies the allegations of Paragraph 10, except that it admits that it is a New York corporation and does business in this district and that NYCRUNS does not contest personal jurisdiction in this district.

11. NYCRUNS does not contest venue in this district.

NYRR AND ITS RUNNING EVENTS

12. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 12.

13. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 13.

14. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 14.

15. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 15.

16. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 16 and footnote 1.

17. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 17.

18. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 18.

19. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 19.

NYRR'S BROOKLYN HALF MARKS

20. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 20.

21. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 21.

22. NYCRUNS denies the allegations in Paragraph 22.

23. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 23, except that it admits that NYRR owns U.S. Registration No. 5,169,507 for BROOKLYN HALF for certain services in International Class 41, that U.S.

Registration No. 5,169,507 for BROOKLYN HALF issued on March 28, 2017, and refers to Exhibit C for the contents thereof.

24. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 24, except that it admits that Exhibit D of the Complaint is a copy of U.S. Trademark Application bearing Serial No. 98/404,926 apparently filed on February 14, 2024, and refers to Exhibit D for the contents thereof. .

25. NYCRUNS denies the allegations in Paragraph 25, except that it admits that NYRR has a registration for BROOKLYN HALF for certain goods and services, and it lacks knowledge or information whether NYRR's registration for BROOKLYN HALF meets the requirements of 15 U.S.C. §§ 1115(b) and 1065.

26. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 26.

27. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 27.

28. NYCRUNS denies the allegations in Paragraph 28.

29. NYCRUNS denies the allegations in Paragraph 29.

30. NYCRUNS denies the allegations in Paragraph 30.

NYCRUNS' INFRINGING ACTS

31. NYCRUNS denies the allegations in Paragraph 31, except that it admits that it organizes and hosts running events in New York City and that NYCRUNS has marketed its 2023 and 2024 half-marathon event in Brooklyn using the name NYCRUNS BROOKLYN HALF MARATHON and that it has used BROOKLYN MARATHON & HALF MARATHON as a trademark.

32. NYCRUNS denies the allegations in Paragraph 32.

33. NYCRUNS denies the allegations in Paragraph 33, except that it admits that NYCRUNS' website states that NYCRUNS served approximately 75,000 runners, and it lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 33 concerning the number of runners and/or students that NYRR allegedly served.

34. NYCRUNS denies the allegations in Paragraph 34, except that it admits that it did not conduct a full marathon in Brooklyn in 2023, and also admits Exhibit E purports to be a screenshot of a page from the NYCRUNS' website and refers to Exhibit E for the contents thereof.

35. NYCRUNS denies the allegations in Paragraph 35, except that it is without knowledge or information sufficient to form a belief as to the truth of the allegations that consumers supposedly contacted NYRR because of alleged confusion, and whether any person mistakenly volunteered at an NYCRUNS' event.

36. NYCRUNS denies the allegations in Paragraph 36.

37. NYCRUNS denies the allegations in Paragraph 37.

38. NYCRUNS denies the allegations in Paragraph 38, including the assertion that it is infringing any trademarks owned by NYRR and that it needed authorization from NYRR to use the NYCRUNS BROOKLYN HALF MARATHON or BROOKLYN MARATHON & HALF MARATHON marks.

39. NYCRUNS denies the allegations in Paragraph 39.

40. NYCRUNS denies the allegations in Paragraph 40, except that it admits that it markets, advertises, and conducts running events, and markets and sells apparel related to the NYCRUNS' events.

41. NYCRUNS denies the allegations in Paragraph 41, except that it admits that it markets, distributes, and advertises its goods and services to runners and consumers interested in running events and has sold goods and services using the NYCRUNS BROOKLYN HALF MARATHON or BROOKLYN MARATHON & HALF MARATHON marks.

42. NYCRUNS denies the allegations in Paragraph 42, except that it admits that it markets and distributes its goods and services through its website, www.NYCRUNS.com, at running events, and on social media, and has offered such goods and services using the NYCRUNS BROOKLYN HALF MARATHON or BROOKLYN MARATHON & HALF MARATHON marks

43. NYCRUNS denies the allegations in Paragraph 43.

44. NYCRUNS denies the allegations in Paragraph 44.

45. NYCRUNS denies the allegations in Paragraph 45, except that it admits that: it received NYRR's letter in February 2023 and refers to that letter for its contents, the parties engaged in settlement negotiations, and NYCRUNS is advertising its 2024 half-marathon running event using the NYCRUNS BROOKLYN HALF MARATHON mark.

46. NYCRUNS denies the allegations of Paragraph 46.

47. NYCRUNS denies the allegations in Paragraph 47.

48. NYCRUNS denies the allegations in Paragraph 48.

49. NYCRUNS denies the allegations in Paragraph 49.

50. NYCRUNS denies the allegations in Paragraph 50.

FIRST CAUSE OF ACTION
(Infringement of a Registered Trademark Under 15 U.S.C. § 1114)

51. NYCRUNS repeats and incorporates herein Paragraphs 1–50 of its Answer to NYRR's Complaint, as if set forth fully herein.

52. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 52.

53. NYCRUNS denies the allegations in Paragraph 53, except that it admits that NYRR has a registration for BROOKLYN HALF for certain goods and services, and it lacks information or knowledge whether NYRR's registration for BROOKLYN HALF meets the requirements of 15 U.S.C. §§ 1115(b) and 1065.

54. NYCRUNS denies the allegations in Paragraph 54.

55. NYCRUNS denies the allegations in Paragraph 55.

56. NYCRUNS denies the allegations in Paragraph 56.

57. NYCRUNS denies the allegations in Paragraph 57.

58. NYCRUNS denies the allegations in Paragraph 58.

SECOND CAUSE OF ACTION
(Unfair Competition Under 15 U.S.C. § 1125(A)(1)(A))

59. NYCRUNS repeats and incorporates herein Paragraphs 1–58 of its Answer to NYRR's Complaint, as if set forth fully herein.

60. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 60.

61. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 61.

62. NYCRUNS denies the allegations in Paragraph 62.

63. NYCRUNS denies the allegations in Paragraph 63.

64. NYCRUNS denies the allegations in Paragraph 64.

65. NYCRUNS denies the allegations in Paragraph 65.

66. NYCRUNS denies the allegations in Paragraph 66.

67. NYCRUNS denies the allegations in Paragraph 67.

THIRD CAUSE OF ACTION
(Refusal of U.S. Trademark Application Serial No. 90/874,072
Under 15 U.S.C. § 1119)

68. NYCRUNS repeats and incorporates herein Paragraphs 1–67 of its Answer to NYRR’s Complaint, as if set forth fully herein.

69. NYCRUNS lacks knowledge or information to form a belief as to the truth of the allegations in Paragraph 69.

70. NYCRUNS lacks knowledge or information to form a belief as to the truth of the allegations in Paragraph 70.

71. NYCRUNS denies the allegations in Paragraph 71.

72. NYCRUNS denies the allegations in Paragraph 72, except that it admits that NYRR has a registration for BROOKLYN HALF for certain goods and services, and it lacks information or knowledge whether NYRR’s registration for BROOKLYN HALF meets the requirements of 15 U.S.C. §§ 1115(b) and 1065.

73. NYCRUNS admits that on August 10, 2021, it filed an application to register BROOKLYN MARATHON & HALF MARATHON in International Class 41 for “Athletic and sporting event services, namely, arranging, organizing and operating athletic competitions in the nature of running competitions; organizing sporting events, namely, running races; providing online information in the field of running races,” which was assigned Serial No. 90874072 (the “’072 Application”) and that Exhibit F purports to be a copy of the ’072 Application and refers to Exhibit F for the contents thereof.

74. NYCRUNS denies the allegations in Paragraph 74.

75. NYCRUNS denies the allegations in Paragraph 75.

76. NYCRUNS denies the allegations in Paragraph 76.

77. NYCRUNS denies the allegations in Paragraph 77.

78. NYCRUNS denies the allegations in Paragraph 78, except that it admits that NYRR has alleged in this action that the BROOKLYN MARATHON & HALF MARATHON mark infringes NYRR's rights in the BROOKLYN HALF Mark.

79. NYCRUNS denies the allegations in Paragraph 79.

FOURTH CAUSE OF ACTION
(Deceptive Acts and Practices in Violation of N.Y. Gen. Bus. Law Section 349)

80. NYCRUNS repeats and incorporates herein Paragraphs 1–79 of its Answer to NYRR's Complaint, as if set forth fully herein.

81. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 81.

82. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 82.

83. NYCRUNS denies the allegations of Paragraph 83.

84. NYCRUNS denies the allegations in Paragraph 84, except that it lacks knowledge or information sufficient to form a belief as to the truth of the allegations concerning when NYRR's use of the BROOKLYN HALF Marks began.

85. NYCRUNS denies the allegations in Paragraph 85.

86. NYCRUNS denies the allegations in Paragraph 86.

87. NYCRUNS denies the allegations in Paragraph 87.

88. NYCRUNS denies the allegations in Paragraph 88.

89. NYCRUNS denies the allegations in Paragraph 89.

FIFTH CAUSE OF ACTION
(Injury to Business Reputation and Dilution in Violation of N.Y. Gen. Bus. Law § 360-L)

90. NYCRUNS repeats and incorporates herein Paragraphs 1–89 of its Answer to NYRR's Complaint, as if set forth fully herein.

91. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 91.

92. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 92.

93. NYCRUNS denies the allegations in Paragraph 93.

94. NYCRUNS denies the allegations in Paragraph 94.

95. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 95.

96. NYCRUNS denies the allegations in Paragraph 96, except that it lacks knowledge or information sufficient to form a belief as to the truth of the allegations concerning when NYRR's use of the BROOKLYN HALF Marks began.

97. NYCRUNS denies the allegations in Paragraph 97.

98. NYCRUNS denies the allegations in Paragraph 98.

99. NYCRUNS denies the allegations in Paragraph 99.

100. NYCRUNS denies the allegations in Paragraph 100.

SIXTH CAUSE OF ACTION
(Unfair Competition Under New York Common Law)

101. NYCRUNS repeats and incorporates herein Paragraphs 1–100 of its Answer to NYRR's Complaint, as if set forth fully herein.

102. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 102.

103. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 103.

104. NYCRUNS denies the allegations in Paragraph 104.

105. NYCRUNS denies the allegations in Paragraph 105.

106. NYCRUNS denies the allegations in Paragraph 106, except that it admits that it has used the NYCRUNS BROOKLYN HALF MARATHON and BROOKLYN MARATHON & HALF MARATHON marks to promote its goods and services.

107. NYCRUNS denies the allegations in Paragraph 107.

108. NYCRUNS denies the allegations in Paragraph 108.

109. NYCRUNS denies the allegations in Paragraph 109.

110. NYCRUNS denies the allegations in Paragraph 110.

SEVENTH CAUSE OF ACTION
(Trademark Infringement Under New York Common Law)

111. NYCRUNS repeats and incorporates herein Paragraphs 1–110 of its Answer to NYRR’s Complaint, as if set forth fully herein.

112. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 112.

113. NYCRUNS lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 113.

114. NYCRUNS denies the allegations in Paragraph 114.

115. NYCRUNS denies the allegations in Paragraph 115.

116. NYCRUNS denies the allegations in Paragraph 116.

117. NYCRUNS denies the allegations in Paragraph 117.

118. NYCRUNS denies the allegations in Paragraph 118.

119. NYCRUNS denies the allegations in Paragraph 119.

EIGHTH CAUSE OF ACTION
(Misappropriation Under New York Common Law)

120. NYCRUNS repeats and incorporates herein Paragraphs 1–119 of its Answer to NYRR’s Complaint, as if set forth fully herein.

121. NYCRUNS denies the allegations in Paragraph 121, except that it lacks knowledge or information sufficient to form a belief as to the truth of amount expended by NYRR in advertising, use and promotion of its BROOKLYN HALF Marks.

122. NYCRUNS denies the allegations in Paragraph 122.

123. NYCRUNS denies the allegations in Paragraph 123.

124. NYCRUNS denies the allegations in Paragraph 124.

125. NYCRUNS denies the allegations in Paragraph 125.

WHEREFORE, NYCRUNS denies NYRR is entitled to any of the relief requested in its Prayer for Relief and prays that judgment be entered for NYCRUNS on all of NYRR’s claims, awarding NYCRUNS its costs and fees and such other and further relief as the Court deems appropriate.

FIRST AFFIRMATIVE DEFENSE

The Complaint fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

NYRR’s claims are barred, in whole or in part, by the applicable statutes of limitations or the equitable doctrine of laches.

THIRD AFFIRMATIVE DEFENSE

NYRR’s claims are barred, in whole or in part, by the doctrines of waiver, acquiescence and/or estoppel.

FOURTH AFFIRMATIVE DEFENSE

NYRR's claims for compensatory damages are barred, in whole or in part, by its failure to mitigate or avoid the purported damages.

FIFTH AFFIRMATIVE DEFENSE

NYRR's BROOKLYN HALF Marks are weak and unenforceable with respect to the conduct of NYCRUNS.

Date: March 25, 2024

Respectfully submitted,

/s/ Richard H. Brown

Richard H. Brown

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CERTIFICATE OF SERVICE

I hereby certify that on March 25, 2024, a true copy of foregoing **Answer and Affirmative Defenses** was filed electronically, and I understand that notice of this filing will be sent by email to all parties receiving electronic notification in this matter via the Court's ECF system.

Date: March 25, 2024

/s/ Richard H. Brown